

REMARKS

I. THE SPECIFICATION

The Office Action asserts that the title is not descriptive. In response, Applicants have amended the title herein.

The Office Action asserts that the application lacks the necessary reference to the prior application. In response, Applicants have amended the specification to include reference to the prior application.

II. THE OBJECTION TO CLAIM 2

The Office Action object to claim 2. In response, Applicants submit that the amendment to claim 2 obviates any basis for the objection thereto. Reconsideration and withdrawal of the objection to claim 2 are respectfully requested.

III. THE REJECTIONS UNDER 35 U.S.C. §§ 101 AND 112, 1st PARAGRAPH

The Office Action rejects claim 10 under 35 U.S.C. §§ 101 and 112, first paragraph, for encompassing cells within the human body. In response, Applicants submit that the amendment to claim 10 obviates any basis for this aspect of the rejection thereto. Reconsideration and withdrawal of the rejection of claim 10 are respectfully requested.

The Office Action rejects claims 2, 3, 8-10 and 19 under 35 U.S.C. §§ 101 and 112, first paragraph, asserting that the specification does not disclose a specific and substantial utility or a well established utility. Applicants respectfully traverse the rejection.

The examiner has the initial burden of challenging an asserted utility. Only after the examiner has provided evidence showing that one of ordinary skill in the art would reasonably doubt the asserted utility does the burden shift to the applicant to provide rebuttal evidence sufficient to convince one of ordinary skill in the art of the invention's asserted utility. In re Swartz, 232 F.3d 862, 863, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000); In re Brana, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing In re Bundy, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)).

Applicants submit that the Office Action has not provided evidence to doubt the utility asserted in the present specification. The present specification discloses, inter alia, the following:

- A number of pathologies are associated with acetylcholine receptors;
- Acetylcholine receptors are made up of subunits;
- An understanding of the subunits would help better understand each subunit's role in acetylcholine receptor activity;
- The present inventors have cloned a novel human acetylcholine receptor subunit.

The Office Action has not provided evidence to doubt that this information has a defined utility. Reconsideration and withdrawal of the rejection of claims 2, 3, 8-10 and 19 are respectfully requested.

IV. THE REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

The Office Action rejects claims 2, 3, 8-10 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite. In response, Applicants submit that the amendment to claims 9, 10 and 19 obviates any basis for the rejection of claims 2, 3, 8-10 and 19 under 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of the rejection of claims 2, 3, 8-10 and 19 are respectfully requested.

V. CONCLUSION

Early consideration and prompt allowance of the claims are respectfully requested.

In the event that any fees are due for entry of the present response the Commissioner is hereby authorized to charge such fees to Deposit Account No. 10-0750/JAB-1529-USACON2/LAD.

Respectfully submitted,

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